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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DIVECHA, KAMAL B

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/923,955

Applicant(s)

SIMPSON ET AL.

Examiner

KAMAL B. DIVECHA

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☒ Claim(s) 2,3,7,10-18 and 20-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/08/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: In figure 8 reference number 804 and 802 were not described in the disclosure and in figure 9 item number 906 was also not considered in the disclosure.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because it contains the legal phraseology such as "comprising" on page 75 lines 3.

Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means", "comprising" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The disclosure is objected to because of the following informalities: the "firewall 12" was intended to be "firewall 14" on page 19 and 21, paragraph 0069 and 0075.

Appropriate correction is required.

5. The disclosure is objected to because it contains an embedded hyperlink (page 34) and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

6. Claims 2, 3, 7, 10-18, 20-28 are objected to because of the following informalities:

- The phrase “the criteria” on line 21 lacks antecedent basis in claim 2.
- The phrase “data structure” on line 25 lacks antecedent basis in claim 3.
- The phrase “the said context” on line 11 lacks antecedent basis in claim 7.
- The phrase “the steps” or “the step” on line 23, 10, 14, and 17 of claims 10-13 lacks antecedent basis.
- The phrase “the context” on line 20, 23 and 26 of claims 14-16 lacks antecedent basis.
- The phrase “data structure” on line 29 lacks antecedent basis in claim 17.
- The phrase “the step” on line 1 of claim 18 lacks antecedent basis.
- The phrase “the steps” or “the step” on lines 10, 21, and 24 lacks antecedent basis in claims 20, 22 and 23.
- The phrase “the criteria” on line 17 of claim 21 lacks antecedent basis.
- The phrase “the step” of claim 23 and claim 24 also lacks antecedent basis.
- The phrase “the context” of claim 25 and claim 26 lacks antecedent basis.
- The phrase “the type” of claim 28 on line 11 lacks antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 5, 17, 21 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being insufficient antecedent basis for the limitations in the claims.

- Claim 3 recites the limitations “data structure” in line 25.
- Claim 5 recites the limitation “the said context” in line 4.
- Claim 17 recites the limitation “data structure” in line 29.
- Claim 21 recites the limitation “said method” in line 17 and 18.
- Claim 29 recites the limitation “said type of website” in line 13.

9. Claims 1, 10, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Regarding claims 1, 10 and 32, the phrase "may be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The subject matter is non statutory because the program product is not limited to the code being tangibly embodied on a computer readable medium so as to enable the methods to be practiced.

- Regarding claim 1, a program product including machine-readable code to provide API, comprising code for automatic selection is being claimed, which is non-statutory subject matter (a code).
- Regarding claim 30, the same argument (as discussed above regarding claim 1) still holds. A program product code for determining appropriate destination, comprising code causing the performance of the methods enclosed, is also non-statutory subject matter (simply a code).

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-4, 6, 10-13, 15, 20-23, 25, 30, 31, 32 rejected under 35 U.S.C. 102(e) as anticipated by Yacoub (U.S. Patent No. 6,452,692 B1).

With respect to claim 1, Yacoub discloses a program product including machine readable code to provide API for a browser extension for use in an imaging client that has a browser, comprising code for providing: a method for automatically selecting (column 4 lines 18-19) one of a plurality of destination methods based on a criteria (column 2 lines 33-34, see abstract); and at least two of the following destination methods: a printer list destination method that may be called to get at least one direct or indirect reference to a printer list destination and cause a browser to browse to that destination (figure 3 step 300-350; column 3 line 53); a printer destination method that may be called to get a direct or indirect reference to a printer destination and cause a browser to browse to that destination (column 7 lines 16-23); and a print now destination method that may be called to get a direct or indirect reference to a PRINT NOW destination that will print using preset printer settings, and cause a browser to browse to that destination (column 3 lines 8-10, figure 4).

With respect to claim 2, Yacoub further discloses the program product as in claim 1, wherein the criteria (preferences) in said method for automatically selecting one of the destination methods is based on a context (location, image, speed, quality, paper size etc) (column 2 lines 29-44).

With respect to claim 3, Yacoub further discloses the program product and data structure as in claim 2, further comprising a method for getting the criteria (figure 2: preferences are selected or obtained through virtual printer in step 210, 220 and 230 and provided to server for the decision) and providing the criteria to the selecting method (column 2 line 30; column 9 lines 45-49).

With respect to claim 4, Yacoub further discloses the program product as in claim 2, further comprising a method for getting a context (figure 2 step 220, 230, 233 and 236).

With respect to claim 6, Yacoub further discloses the program product as in claim 4, wherein said context is a current location of client machine (column 11 lines 7-10).

With respect to claim 10, Yacoub discloses a selection method for determining an appropriate destination, comprising the steps of: automatically selecting (column 4 lines 18-19) one of a plurality of destination methods based on a criteria (column 2 lines 33-34, see abstract); and calling at least one of the following destination methods: a printer list destination method that may be called to get at least one direct or indirect reference to a printer list destination and cause a browser to browse to that URL destination (figure 3 step 300-350; column 3 line 53); a printer destination method that may be called to get a direct or indirect reference to a printer destination and cause a browser to browse to that URL destination (column 7 lines 16-23); and a print now destination method that may be called to get a direct or indirect reference to a PRINT NOW destination that will print using preset printer settings, and cause a browser to browse to that URL destination (column 3 lines 8-10, figure 4).

Claims 11, 12, 13 and 15 are rejected under same rationale as claims 2, 3, 4 and 6 (see above).

With respect to claim 20, Yacoub further discloses a selection method for determining an appropriate destination, comprising the steps of: automatically selecting one of a plurality of destination methods based on criteria (see abstract); calling the selected destination method (figure 3 step 300, 310, 315, 320 and 330); and getting at least one direct or indirect reference to the selected destination (figure 3 step 340 and 350).

Claims 21, 22, 23 and 25 are rejected based on same rationale as in claims 11, 12, 13 and 15 (see above).

Claim 30 is rejected under the same rationale as claim 20 as set forth above. Regarding code for causing the performance of method steps, a method is developed in order to improve the performance.

With respect to claim 31, Yacoub discloses a system for determining an appropriate destination, comprising: a component (a server) for automatically selecting one of a plurality of destination methods based on criteria (column 2 lines 29-44); a component (GUI menu in the client workstation) for calling the selected destination method (figure 3 step 300, 310, 315, 320 and 330); and a component (a server) for getting at least one direct or indirect reference to the selected destination (see abstract, figure 3 step 340 and 350).

With respect to claim 32, Yacoub discloses a system for determining an appropriate destination, comprising: a component (a server in figure 6) for automatically selecting one of a plurality of destination methods based on criteria (column 2 lines 29-44); and a component (figure 6 component number 700 and 710) for calling at least one of the following destination method (figure 3 step 300, 310, 315, 320 and 330); a printer list destination method that may be called to get at least one direct or indirect reference to a printer list destination and cause a browser to browse to that URL destination (figure 3 step 300-350; column 3 line 53); a printer destination method that may be called to get a direct or indirect reference to a printer destination and cause a browser to browse to that URL destination (column 7 lines 16-23); and a print now destination method that may be called to get a direct or indirect reference to a PRINT NOW

destination that will print using preset printer settings, and cause a browser to browse to that URL destination (column 3 lines 8-10, figure 4).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 7, 17 and 27 are rejected under 35 U.S.C. 103(a) as being obvious over Yacoub (U.S. Patent No. 6,452,692 B1) in view of "official Notice".

As per claim 7, Yacoub discloses the limitations of claim 4, 2, and 1 wherein Yacoub does not explicitly show the program product as in claim 4, wherein the said context includes a type of website.

As per claim 17, Yacoub discloses the limitations of claims 11 and 10 wherein Yacoub does not explicitly show the program product and data structure as in claim 11, wherein the context includes a type of website.

As per claim 27, Yacoub discloses the limitations of claims 21 and 20 wherein Yacoub does not explicitly show the program product and data structure as in claim 21, wherein the context includes a type of website.

However, it would have been obvious to the one skill in the art to incorporate the limitations set forth above in order to further show the type of document or web content that needs to be printed and help in locating the document on network.

16. Claims 5, 8, 9, 14, 16, 18, 19, 24, 26, 28 and 29 are rejected under 35 U.S.C. 103(a) as being obvious over Yacoub (U.S. Patent No. 6,452,692 B1) in view of "official Notice" in further view of Goodman (U.S. Pub No. US 2003/0009672 A1).

Yacoub in view of official notice discloses all the limitations of claims 7, 4, 2, 1, 11 and 12.

Yacoub in view of official notice does not explicitly disclose:

With respect to claim 5, the program product as in claim 4, wherein said context includes the URL of web content.

With respect to claim 16, the method as in claim 11, wherein the context includes a network address of the machine on which the browser operates.

Goodman explicitly discloses method and system for real-time control of document printing (see abstract), including intercepting a print request for an original document by a user, obtaining print information corresponding to the document and sending the print request and the

print information to the print server. The said print information comprises the print attributes (see table 1 on page 8) and watermark attributes (page 9 table ii) which includes the document URL and ID and the address of the client machine.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Goodman as stated above with the method of Yacoub in view of official notice for including URL of web content and the network address of the machine on which the browser operates in the context because it would help to locate the source of the document that needs to be printed on the network and also the network address would have been used by the print server to find the closest available printer on the network to the client. Hence it would have improved the printing services and any relating latency.

17. With respect to claims 8, 19 and 29, Goodman does not explicitly disclose the program product as in claims 7, 17 and 27, wherein said type of website is one of the following: a productivity application website, an informational website, or a report generation website.

However, Goodman shows the web server computer (figure 1 element number 105), which would have stored all types of websites and documents including the types mentioned above.

18. Neither of the references above teaches the limitations of claims 9, 18, and 28 but it would have been obvious to include a method for determining the type of a website in the Yacoub in view of official notice and in further view of Goodman's method because it would have caused a print server software to redirect the print request to a printer that specifically handles the printing services of particular type of websites. In general it would have helped print server to make and pick a right printer among the available printers.

Additional References

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Yanagidaira U.S. Patent No. 6,490,052 B1


b. Iida U.S. Patent No. 6,671,063 B1

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is N/A. The examiner can normally be reached on 8.30am-5.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maung Zarni can be reached on 703-308-6687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ZARNI MAUNG
PRIMARY EXAMINER